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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Kevin James Brusky et al

Confirmation No.: 5699

Application No.: 08/941174

Examiner: BROWN, Reuben M.

Filing Date: Sep 30, 1997

Group Art Unit: 2623

Title: APPARATUS AND METHOD FOR USING KEYBOARD MACROS TO CONTROL VIEWING
CHANNEL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in triplicate is the Reply Brief with respect to the Examiner's Answer mailed on 07/13/2006. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

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Respectfully submitted,

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Application No. 08/941,174
Group Art Unit 2611
Appeal Brief - August 22, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	08/941,174	Confirmation No.	5699
Filed:	9-30-1997	Examiner:	BROWN, Reuben M.
Inventor(s):	BRUSKY, K. et al.	Group Art Unit:	2623
For:	Apparatus and Method for Using Keyboard Macros to Control Viewing Channel	Attorney Docket No:	200303806-1

Mail Stop Appeal Brief - Patents

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August 22, 2006
Date


N. Rhys Merrett

REPLY BRIEF

This is in response to the Examiner's Answer mailed July 13, 2006 in this proceeding.

Grounds of Rejection.

The grounds of rejection presented in the Examiner's Answer appear to be identical to those set forth in the Office Action mailed July 20, 2004 except that on page 6, first complete paragraph, the first sentence has been expanded to state: *"Regarding the additional claimed feature of the alphanumeric keyboard containing a key with an associated channel macro for selecting a predetermined network or Internet site name, Gateway 2000 does not explicitly disclose such a feature, even though the reference does discloses (sic) that the subscriber may browse through the TV guide according to station call signs, see page 3."* (Underlined material added in the Examiner's Answer.) The Gateway 2000 Features reference does not disclose or suggest that the "wireless keyboard (full size)" incorporates such a "browse function" and thus does not disclose or suggest that the features of the claims under appeal in which keys for user selection of a "stored network name or internet site name" (claim 8, with similar recitations in claims 20 and 24), are provided by the "keyboard for providing alphanumeric characters to said PC/TV system" as recited in claim 8 with similar recitations in claims 20 and 24. To the contrary,

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Gateway 2000 Features on page 4 explicitly disassociates the channel selection features from the wireless keyboard and explicitly teaches: "The Field Mouse remote features consumer buttons that allow for operation of the television just like a conventional remote"

Appellants' Discussion of the References.

The Examiner seems to attack various arguments made in the Appeal Brief on the basis that they are "moot" the Examiner asserting all three references were not discussed together, or were discussed in a different manner. Appellants disagree. In the Appeal Brief, Appellant discussed the Gateway 2000 Features reference, then Yoshida in conjunction with Gateway 2000 Features and then Siitonen in conjunction with Yoshida and Gateway 2000 Features. It is believed the argumentation in the Appeal Brief is properly presented and is responsive to the grounds of rejection.

Examiner's Interpretation of Gateway 2000 Features and Yoshida

The publication Gateway 2000 Features lists features of a "Destination™ Big Screen PC" disclosed as being a TV and PC (page 1, first two paragraphs) having a monitor with "a full 31-inch viewable area" (page 3 "Monitor"). Disclosed features include a "wireless keyboard (full size!)" and Field Mouse remote". "The Field Mouse remote features consumer buttons that allow for operation of the television just like a conventional remote as well as a large trackball for easy cursor control. The keyboard sports an EZ Pad™ pointing device and a special "baby sitter" button that with one click takes you to television." (Gateway 2000 Features – page 4 – underlining added.) Unequivocally, this teaches that it is the "Field Mouse" remote – **not** the wireless keyboard - that is to be used for operation of the television "just like a conventional remote." * Gateway 2000 Features teaches separate functions for the wireless keyboard (PC mode) and the "Field Mouse" remote for television operation. A person of ordinary skill in the art at the time of the invention considering the teachings of Gateway 2000 Features and Yoshida would not have been motivated to attempt to use the teaching of Yoshida to modify the Gateway 2000 Features "wireless keyboard (full size!)" in the face of the clear teaching by Gateway 2000 Features that it is the "Field Mouse" remote that is to be used "for operation of the television just like a conventional remote" (see above).

* This is further supported by the keyboard feature of a special 'babysitter' button that with one click "takes you to television" – implying use of the keyboard for operation of the PC. (Emphasis added.)

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The Examiner asserts (Examiner's Answer, pages 11/12): "Thus , examiner respectfully disagrees with appellant's assertion on page 11, that 'Consequently, on an interpretation most favorable to the examiner, Yoshida would [at] most hypothetically suggested modification of the Gateway 2000 Field Mouse remote', since one of ordinary skill in the art would have readily recognized the benefit of using either device type for television operation." With respect, this speculation by the Examiner is devoid of merit. Such hypothetical modification would directly contradict the clear teaching and change the principle of operation of Gateway 2000 Features - see MPEP 2143.01 VI. Further, the contention "one of ordinary skill in the art would have readily recognized the benefit of using either device type for television operation" is speculation by the Examiner and unsupported by objective evidence. Nothing is seen in Gateway 200 or Yoshida to have motivated a person of ordinary skill in the art to have added Yoshida's channel selection features to the Gateway wireless keyboard taught by Gateway 200 to be used for PC mode operation , channel selection already having been explicitly provided in the Gateway 2000 Features Field Mouse – see discussion above. The "keyboard for providing alphanumeric characters to said PC/TV computer" recited in the context of claim 8; the "alphanumeric keyboard for providing alphanumeric information to said computer system" recited in the context of claim 20; and the "keyboard for providing alphanumeric characters in said PC/TV computer" as recited in claim 24, all are generally comparable in functionality to the Gateway keyboard for PC mode operation, except for the additional features provided by the claimed invention relating to 'channel selection' and which are beyond the contemplation of the Gateway 2000 Features reference. Consequently, the hypothetical modification of the Gateway 2000 Features Field Mouse remote control would not have resulted in the combination of elements recited in any of claims 8, 20 and 24, each claim considered as a whole even taking account of the teachings of Siitonen and consequently the references relied on by the Examiner do not together teach or suggest all limitations of those claims – see MPEP 2143.03.

Examiner's Faulty Claim Analysis

The discussion at page 12 of the Examiner's Answer, referring to Appellants' specification at page 1, lines 17-24, is off point. The Examiner contends: "It is pointed out that as such, the particular alternative input device is recognized as not an essential feature of the invention, since all these input devices contain similar input mechanisms that will operate the invention."

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The expression "the invention" has no meaning outside the context of the claims. Features essential to the invention claimed in a particular claim are those features as recited in the claim. Recognition by the inventors, in the context of the inventive activity, that certain input devices may be used in implementing the convergence system described in the specification does not admit or imply that use of any of the devices in the invention as claimed in a particular claim would have been obvious from the prior art, not that any would be equivalent to the input device recited in the claims. This discussion by the Examiner is again indicative of improper hindsight analysis based on contents of appellants' specification instead of the prior art.

On page 14 of the Examiner's Answer, it is contended: "Examiner notes that the technique of searching a database of items according to alphabetical order is a well-established function and was not a patentably distinct feature at the time the invention was made." This contention is diversionary and lacks meaning. There is no such thing as a "patentably distinct feature" and inventions frequently arise from a combination of old elements. *In re Kotzab* 55 USPQ2d 1313 (CA FC 2000). Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.

Conclusion

For the reasons contained in the Appeal Brief and this Reply Brief, it is believed this Appeal against the Examiner's rejection of the claims under appeal should be reversed and all claims on Appeal should be allowed.

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Respectfully submitted,



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